

TTAB

Respondent.

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Registration No. 2,089,082

U.S. Patent &amp; TMO/c/TM Mail Rcpt Dt. #22

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The present petition to cancel Reg. 2089082 was filed on March 29, 2001, Cancellation No. 31,904. It is based on Section 2(d) of the Trademark Act, alleging that respondent's mark so resembles a mark or trade name which petitioner has previously

used (and not abandoned) in connection with goods or services so similar to those identified in respondent's registration as to cause confusion, mistake or deception.

Respondent made discovery requests (interrogatories, production and admissions) on petitioner to which petitioner responded.

Petitioner attempted to take a testimony deposition of its principal officer (Mark Graham) by written questions, which respondent successfully opposed. Petitioner then took an oral testimony deposition of Mark Graham, which respondent's attorney attended and cross-examined.

Respondent took a testimony deposition of its account manager, Todd Levy, which petitioner's attorney attended and cross-examined.

Petitioner filed a motion for summary judgment on October 2, 2002, which was denied by the TTAB on October 31, 2002

#### Statement of the Facts

The Reg. No. 2080982 of the words BELL PACKAGING CORPORATION for the goods noted above, disclaims exclusive right to use of PACKAGING CORPORATION apart from the mark as shown. So the distinctive portion of the mark is BELL.

The testimony of Mark Graham establishes that respondent, under its previous name Bell Paper Box Company, was founded in 1920 (Graham deposition, p. 23) and identified a catalog cover dated January 1932 (Exhibit 6).

Exhibits 1A through 1N were identified as examples of packages made by Petitioner. Exhibits 2A through 2E were identified as letterhead and business papers bearing the “Bell Incorporated” name. Exhibit 3 is current promotional material used by Bell Incorporated. Exhibit 4 is earlier promotional material of Bell Paper Box Inc.

Exhibit 5 comprises Petitioner’s tax returns for 1992 through 2001 showing that Petitioner was very substantially in business during that period of time prior to issuance of Reg. No. 2089082 and institution of the present cancellation proceedings.

From the testimony deposition of Todd Levy, it appears that respondent has used a trade name including BELL, since 1940.

#### Issue

The sole issue in this case is whether petitioner had used and was using BELL as part of its trademark or trade name, prior to respondents filing date of July 3, 1996 and issuance date of August 19, 1997.

#### Argument

The present petition to cancel was filed March 29, 2001. The Reg. No. 2089082, which issued August 19, 1997, would begin its fifth year on August 19, 2002. So this cancellation was instituted within the five-year period after registration. A petition to cancel filed prior to the expiration of the five-year period may be based on any ground, which could have prevented registration initially. *Person’s Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477 (Fed. Cir. 1990); *International Mobile Machines Corp. v. International Telephone and Telegraph Corp.*, 800 F.2d 1118, 231 USPQ 142 (Fed. Cir.

1986); *International Order of Job's Daughters v. Lindeburg and Co.*, 727 F.2d 1087, 220 USPQ 1017 (Fed. Cir. 1984); and *Kellogg Co. v. Pack'Em Enterprises, Inc.*, 14 USPQ2d 1545 (TTAB 1990); *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

One such ground, which could have prevented the registration, is expressed in Section 2(d) of the Act, 15. U.S.C. §1052(d) (i.e., that respondent's mark so resembles a mark registered in the PTO, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods or services of the respondent, to cause confusion, or to mistake, or to deceive). *Opryland USA Inc. v. The Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Person's Co. v. Christman*, *supra*; *Strang Corp. v. Stouffer Corp.*, 16 USPQ 2d 1309 (TTAB 1990); and *Liberty Trouser Co. v. Liberty & Co.*, 222 USPQ 357 (TTAB 1983).

At the time the respondent's Reg. 2089082 was issued and before its filing date, petitioner had been using BELL as the distinctive portion of a trade name and trademark, i.e., BELL PAPER BOX COMPANY and BELL INC. Its use began in 1920. There is abundant evidence from the deposition of Mark Graham and the exhibits identified by him, that petitioner had made extensive use of BELL as a trademark and trade name in connection with its line of paper and paper board packaging, and its services of custom designing such packaging (Graham Dep. pp. 29-31).

From the testimony of the witnesses, it appears that petitioner's use of BELL began in 1920 and respondent's use of BELL began in 1940. However, at this point, priority is not an issue. Petitioner's burden is to prove that at the time when the

application which resulted in Reg. No. 2089082 was filed, Petitioner had previously used (and not abandoned) a mark or trade name, the distinctive element of which is BELL; and had used such mark or trade name in connection with goods and/or services similar to those identified in the registration.

The paper and paperboard containers of petitioner and its custom designing of such containers are clearly embraced by the identification of goods in Reg. No. 2089082, although that identification includes a broader range of goods and services than those of the petitioner.

Petitioner submits that it has fully met its burden of proof in this cancellation proceeding.

Conclusion

Petitioner has established that before respondent filed for Reg. No. 2089082, petitioner had pre-existing use of BELL as a trademark and/or tradename in connection with paper and paperboard packaging containers and custom design services relative thereto. Under Section 2(d) of the Trademark Act, respondent was not entitled to the registration and the legal rights and presumptions inherent therein. Accordingly, this petition to cancel should be granted and the Reg. No. 2089082 should be cancelled.

Respectfully submitted,

  
J. W. Gipple, Attorney for Petitioner


December 10, 2003  
Z-1604

CERTIFICATE OF MAILING AND SERVICE

I hereby certify that the foregoing Petitioner's Brief is being mailed first class  
U.S. mail, postage prepaid to Trademark Trial and Appeal Board, U.S. Trademark Office,  
2900 Crystal Drive, Arlington, Virginia 22202-3513 and upon Counsel for respondent.

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This 12<sup>th</sup> day of December 2003.

  
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